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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,181	11/10/1999	Snezna Rogelj	UNME-0054-1	7645

7590

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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 05/28/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/424,181**

Applicant(s)  
**Rogelj**

Examiner  
**David Lukton**

Art Unit  
**1653**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) 9, 10, and 12-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Pursuant paper No. 17 (filed 3/13/02), no claim has been added, cancelled, or amended. Claims 1-35 remain pending. Claims 1-8 and 11 are examined in part; claims 9, 10, 12-35 are withdrawn from consideration.

Applicants' arguments filed 3/13/02 have been considered and found not persuasive.

✱

Claims 1-8 and 11 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is indefinite as to the intended structures.
- Claims 3-5 recite the term "sulfonate". This term renders the claims indefinite. The term at issue could encompass a salt of a sulfonic acid, or an ester of a sulfonic acid. Which is intended?

✱

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the

United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Braxton (U.S.P. 5,798,249).

As indicated previously, Braxton discloses (col 5, line 18) that anti- PDIH antibodies are useful for inhibiting PDIH. In response, applicants have argued that when an applicant asserts a priority claim to a document that has a given filing date, that assertion confers upon the application an effective filing date which is equivalent to the file date of the priority document. However, applicants are not correct. A priority claim is just that, i.e., an assertion. In the instant case, there are very significant differences between the disclosure of provisional application 60/046487, and that of application 09/424181. For example, it does not appear that the following phrase appears anywhere in the disclosure of provisional application 60/046487: “membrane-impermeable inhibitor of protein disulfide isomerase”.

The following passage is noted (page 1, S.N. 60/046487):

“...PAO, PAO analogs and a plurality of vicinal dithiol reagents inhibit HIV entry into cells ... these reagents inhibit ... PDI by ...blocking the active site...”

However, this is quite different from what is recited in instant claim 1.

The rejection is maintained.

✱

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Chandrashekar (USP 6,309,644).

As indicated previously, Chandrashekar discloses (e.g., table 17, col 51) that the compound MDC (mono-dansyl-cadaverine) inhibits PDI.

As indicated above, all priority claims are subject to scrutiny. It is not the case that applicants have achieved "constructive reduction to practice" as of 5/14/97. In further traversing, applicants should point to specific passages of the priority document in defending their assertion of priority to 5/14/97.

The rejection is maintained.

✱

Claim 1 is rejected under 35 U.S.C. §102(b) as being anticipated by Ryser (*PNAS* 91, 4559, 1994).

Ryser discloses (e.g., abstract) that bacitracin is an inhibitor of PDI, and further discloses a monoclonal antibody directed at PDI. Thus, the claim is anticipated.

✱

Claim 1 is rejected under 35 U.S.C. §102(a) as being anticipated by Morjana (*Biochem* 30, 4985, 1997)

Morjana discloses various peptide inhibitors of PDI. As noted above, applicants priority claim does not encompass all embodiments of instant claim 1.

Serial No. 09/424,181  
Art Unit 1653

-5-

Thus, the claim is anticipated.

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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800